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REMARKS

This is a fully and timely response to the final Office Action mailed May 3, 2005. Reconsideration of the application in light of the following remarks is respectfully requested.

By the present amendment, claims 4-6, 15, 18-21, 33-35, 47 and 60 have been cancelled. Claims 1, 11, 16, 17, 24-28, 30-32, 38-43 and 46 were cancelled previously. No claims are added herein. Thus, claims 2, 3, 7-10, 12-14, 22, 23, 29, 36, 37, 44, 45 and 48-59 remain pending for further action.

Allowable Subject Matter:

In the outstanding final Office Action, the Examiner indicates the presence of allowable subject matter in dependent claims 45, 47 and 50-58. Applicant wishes to thank the Examiner for this identification of allowable subject matter.

By the present amendment, all the recitations of allowable claim 47 have been added to independent claim 2, and claim 47 has been cancelled. Consequently, claim 2 and its dependent claims should be placed clearly in condition for allowance by the present amendment due to the allowable subject matter identified by the Examiner in claim 47.

Additionally, claim 4 has been cancelled, and claims 50-52 have each been rewritten as independent claims including all the recitations of cancelled claim 4. Consequently, claims 50-55 should be in condition for immediate allowance following entry of this amendment based on the identification by the Examiner of allowable subject matter in those claims.

Claim 58 has likewise been rewritten as an independent claim including all the recitations of cancelled claim 15. Consequently, claim 58 should be in condition for immediate allowance following entry of this amendment based on the identification by the

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Examiner of allowable subject matter in claim 58. Claim 59 has also been rewritten as an independent claim and is thought to be allowable for the same reasons that claim 51 was held allowable.

§ 102 Rejection based on Schwenk:

With regard to the prior art, the present Office Action rejects claims 2, 3, 7-9, 12-14, 18, 22, 29, 36, 44 and 49 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,704,403 to Schwenk et al. ("Schwenk"). This rejection is moot as to claim 18, which is cancelled by the present amendment.

With regard to claim 2, following entry of this amendment, claim 2 will be allowable over Schwenk due to the inclusion in claim 2 of all the recitations of formerly dependent claim 47, which was indicated in the final Office Action as containing allowable subject matter.

Claim 2, as amended herein, recites:

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a user interface for controlling said adding of ink to said ink cartridge;
wherein said user interface is configured to allow said user to pay for adding ink to said ink cartridge.

Consequently, claims 2, 3, 9, 48 and 49 should now be in condition for allowance.

Claim 7 recites:

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;

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a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a cartridge diagnostic unit for evaluating said cartridge prior to refilling said cartridge to determine to what extent said cartridge can be refilled.

In contrast, Schwenk does not teach or suggest the claimed "cartridge diagnostic unit for evaluating said cartridge prior to refilling said cartridge to determine to what extent said cartridge can be refilled." Similar subject matter is also recited in other pending claims, for example, claim 22.

On this point, the final Office Action refers to Schwenk at col. 11, line 62 through col. 12, line 2. This portion of Schwenk states that:

Through the actuation the start key (key E1) the program is started, which first senses whether the above-discussed start conditions are satisfied. As far as a system fault is detected, this is displayed (display element A9).

So long as the startup pre-conditions are satisfied, the closure flap 79 can be opened. Thereupon the print head 100 is introduced and the closure flap 79 is again capable of being closed. Insofar as there is an ink supply in the device and all further safety conditions are satisfied, the refill process can be started.

Thus, the cited portion of Schwenk does not teach or suggest a diagnostic unit that evaluates a cartridge prior to refilling that cartridge. Rather, the cited portion of Schwenk teaches that various pre-conditions are satisfied and "[t]hereupon the print head 100 is introduced." Thus, it would appear that the "startup pre-conditions" are satisfied *before* the print head is even introduced and, therefore, *cannot* include an evaluation of the print cartridge itself. The Schwenk patent does not ever describe what exactly the "startup pre-conditions" are, and most certainly does not teach or suggest that such conditions include an evaluation of the print cartridge by a diagnostic unit as recited in claim 7.

Moreover, claim 7 recites that the diagnostic unit "determine[s] to what extent said cartridge can be refilled." In contrast, the Schwenk patent only mentions undefined "startup

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pre-conditions" and other undefined "safety conditions," that determine whether ink can be added to the print head at all. Nowhere does Schwenk teach or suggest a diagnostic unit that determines "to what extent" a cartridge can be refilled based on an evaluation of the cartridge itself.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, the rejection of claims 7, 8, 22, 23 and 29 based on Schwenk should be reconsidered and withdrawn.

Similarly, claim 36 recites:

A system of adding ink to an ink cartridge, said system comprising:
means for receiving said ink cartridge in an ink cartridge refilling system;
means for adding ink to said ink cartridge; and
means for evaluating an ability of said ink cartridge to receiving additional ink
and provide an ink cartridge evaluation prior to adding ink to said ink cartridge.
(emphasis added).

As demonstrated above, Schwenk does not teach or suggest means for evaluating an ink cartridge, particularly, its ability to receive additional ink. Moreover, Schwenk does not teach or suggest providing that evaluation *prior* to adding ink to the cartridge as recited in claim 36.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, the rejection of claims 36 and 37 based on Schwenk should be reconsidered and withdrawn.

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Claim 44 recites:

A method of adding ink to an ink cartridge, said method comprising:
placing said ink cartridge in an ink cartridge refilling system;
ascertaining information about said ink cartridge; and
if said information about said ink cartridge matches predetermined parameters,
refusing to add ink to said cartridge with an automated refilling mechanism of said ink
cartridge refilling system.

In contrast, Schwenk does not teach or suggest "refusing to add ink to said cartridge" "if said information about said ink cartridge matches predetermined parameters," as claimed. On this point, the recent final Office Action cites Schwenk at col. 12, lines 24-29. This portion of Schwenk reads: "As a further safety aspect a time limitation for the filling process is provided. In the case that the predetermined time runs out before the fill process is brought to a successful completion, a system failure is indicated and the refill process is interrupted." Thus, Schwenk merely teaches that if it is taking more than a predetermined amount of time to fill a cartridge, the "refill process is interrupted." It is unclear how this can be characterized as "refusing to add ink to said cartridge." To the contrary, Schwenk is teaching that ink is added to the cartridge and then merely explains a means to avoid overfilling the cartridge to which ink is being added.

Moreover, claim 44 recites "refusing to add ink to said cartridge" if "information about said ink cartridge matches predetermined parameters." The cited portion of Schwenk merely teaches interrupting a flow of ink based on the amount of time the system has been adding ink to the cartridge. The cited portion of Schwenk does not teach or suggest that information about the ink cartridge is compared to predetermined ink cartridge parameters to determine whether any ink is or is not provided. Consequently, Schwenk does not teach or

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suggest the claimed method of "refusing to add ink to said cartridge" if "information about said ink cartridge matches predetermined parameters."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, the rejection of claim 44 based on Schwenk should be reconsidered and withdrawn.

§ 103(a) Rejection Based on Schwenk and Howlett:

Claims 4-6, 10, 15, 19-21, 23, 33-35, 37, 48, 51 and 59 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Schwenk and U.S. Patent No. 5,203,387 to Howlett et al. ("Howlett").

Claim 10 recites:

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a receipt printer.

The final Office Action recognizes that Schwenk does not teach or suggest the claimed "receipt printer" and so seeks to combine the teachings of Howlett with those of Schwenk. (Action of May 3, 2005, p. 3). However, Howlett does not teach or suggest a receipt printer either.

On this point, the final Office Action cites Howlett at col. 13, lines 46-66. This portion of Howlett teaches:

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a side-label printer (block 118), which side-label printer is conventional in the art and provides a physical label having the information written thereon as to the contents of the can, such as color, which label is attached to the [paint] can as it is conveyed out of accumulator-storage, as described below with regards to FIG. 30A. Block 120 indicates the information is also sent to the bar-code printer for developing a bar-code label to be attached to the bottom of the can on the bottom lid thereof, which bar-code label includes the general information as to the customer, relevant specifics, and so forth, such as line number, shipping point, formula, all of which is achieved by having the bar-code refer to a specific memory-address in the VME system, which memory-address is specific to that particular order, and includes therein, among other information, the formula for formulating the color desired for that paint can, which formula, of course, will control the operations of each station 16, 18 of each cell "ACCUTINTER", and the dispensing of the colorants and base to form the desired color.

Thus, Howlett teaches a printer which prints a side-label and a bar-code to be attached to a can of paint. Howlett does not teach or suggest a "receipt printer" as claimed.

Paragraph [0036] of Applicant's specification defines what is meant by a "receipt printer."

A record of money spent during the transaction may be kept or shared online, and the station (103) preferably includes means for producing a hard-copy record of the transaction. This printed record is preferably produced, for example, by a receipt and diagnostic printer (110) in the station (103). The printed record may typically include the fees charged for refilling the cartridge, but may also include, for example, additionally or alternatively, diagnostic information on the cartridge, ink selection information, etc.

This is entirely consistent with the standard art-recognized definition of the term "receipt" as being "an acknowledgment (usually tangible) that payment has been made."

(www.onelook.com). In contrast, Howlett does not teach or suggest a printer that produces a receipt, or record of a financial transaction, within the meaning of Applicant's claims. For at least this reason, the rejection of claim 10 and its dependent claims should be reconsidered and withdrawn.

Moreover, the Schwenk device does not accept payment for the ink added to a print head. Consequently, there would be no motivation to add a receipt printer to the Schwenk

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system, even if Howlett did teach a receipt printer as claimed. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990)." M.P.E.P. § 2143.01. For at least this additional reason, the rejection of claim 10 and its dependent claims based on Schwenk and Howlett should be reconsidered and withdrawn.

Claim 59 has been rewritten herein as an independent claim and is thought to be allowable for the same reasons that the Examiner indicated claim 52 as allowable.

§ 102 Rejection based on Kong:

Claim 60 was rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,273,151 to Kong ("Kong"). This rejection is rendered moot by the cancellation herein of claim 60.

Conclusion:

Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The present amendment makes only those changes needed to place the application in condition for allowance based on allowable subject matter indicated by the Examiner. The amendment does not raise new issues requiring further search or consideration. Therefore, entry of the present amendment is proper under 37 C.F.R. § 116 and is hereby requested.

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For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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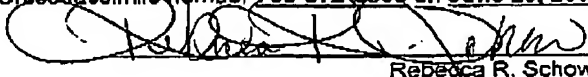
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